

**REMARKS**

This communication is intended to fully respond to the Examiner's Office Action mailed February 1, 2007. The Examiner's issues are listed here in the order in which they are addressed.

- I. Claims 7 and 21 are objected to because of lack of commas (but are otherwise allowable).
- II. The drawings are objected to for allegedly being unclear.
- III. The specification is objected to because of the reference to Figures 3a and 3b.

**I. The Claims Have Been Amended**

The Examiner has rejected Claims 7 and 21 are objected to because of lack of commas (but are otherwise allowable). To further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 7 and 21 in the manner suggested by the Examiner. The Applicants respectfully request that the Examiner allow the claims.

**II. Higher Resolution Drawings Are Provided**

The Examiner objects to the drawings. The Examiner argues that Figures 1, 2a and 2b "are sufficiently poor enough that it is difficult to determine what is actually being described." Applicants respectfully disagree. Figure 1 (which is merely the wild type Group 1 td intron of bacteriophage T4) simply shows sequence information, albeit in small print. With respect to Figures 2a and 2b, the specification notes at page 35 that one is to look at "the bands above the dark bands" and compare the Theo+ lanes with the Theo- lanes (p. 35, lines 1-3, emphasis added). When one examines the originally filed figures, one sees bands above the dark bands under the Theo+ lanes that are not present in the Theo - lines (see e.g. Figure 2A).

Nonetheless, Applicants provide a larger print version for Figure 1 and higher resolution drawings for Figures 2a and 2b. Now the bands above the dark bands are even more evident. The Examiner is respectfully requested to withdraw the present objection.

Before moving on, however, Applicants wish to briefly address the Examiner's statements concerning written description and enablement. With regard to written description, the law has evolved considerably with the recent Federal Circuit decisions of *Capon v. Eshhar v. Dudas*, 418 F.3d 1349 (Fed. Cir. 2005) and *Falkner v. Inglis*, 79 USPQ2d 1001 (Fed. Cir. 2006). In the *Capon* case, the specification (let alone the claim) did not contain a single sequence. Similarly, in the *Falkner* case, the specification provided no sequences. The Federal Circuit found that the claims were nonetheless adequately supported in both cases. The Federal Circuit's decision in the *Falkner* case was unanimous and contained the following warning:

“Specifically, we hold, in accordance with our prior case law, that (1) examples are not necessary to support the adequacy of a written description (2) the written description standard may be met (as it is here) even where actual reduction to practice of an invention is absent; and (3) there is no *per se* rule that an adequate written description of an invention that involves a biological macromolecule must contain a recitation of known structure.”

It is respectfully submitted that the present case is in an even better posture than the *Capon* or *Falkner* case. In the present case, each independent claim contains the polynucleotide sequence. Furthermore, the specification contains examples. The gel results in Figure 2a and 2b are not necessary to an understanding of the invention, since it is adequately set forth in the text and the sequences are in the claims.

With respect to enablement, all that is required is that a protocol is provided that permits one skilled in the art to create the claimed subject matter without undue experimentation. Again, having the specific sequence in Claims 7 and 21 furthers this goal. Having detailed examples on how the constructs are built ends the inquiry. The gel results of Figure 2a and 2b are not necessary.

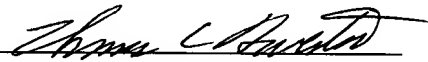
### **III. Figures 3a and 3b Are Proper**

The Examiner indicated in the Office Action (at pg 3) that reference to Figures 3a and 3b on pages 10, 38 and 39 of the specification is not proper since Figure 3 is not labeled 3a and 3b. Applicants now provide Figures 3a and 3b (the two panels have simply be labeled without adding any new matter). Now the text on page 10 is in accordance with the figures. The text on page 38 is also proper (with the exception that there is a typo – that has been now fixed by amendment – that makes reference to Figure 4a instead of Figure 3a). The Examiner is respectfully requested to withdraw the present objection to the specification.

**CONCLUSION**

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

Dated: August 2, 2007

By:   
Thomas C. Howerton  
Reg. 48, 650

Medlen & Carroll, LLP  
101 Howard Street, Ste. 350  
San Francisco, CA 94105  
617-984-0616